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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,406	09/29/2000	Benoit Vialle	24530.00600	9675
49637 7590 07/15/2008 BERRY & ASSOCIATES P.C. 9255 SUNSET BOULEVARD SUITE 810 LOS ANGELES, CA 90069				
EXAMINER BAUTISTA, XIOMARA L.				
ART UNIT		PAPER NUMBER		
2179				
MAIL DATE		DELIVERY MODE		
07/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/675,406

Applicant(s)

VIALLE ET AL.

Examiner

X. L. Bautista

Art Unit

2179

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-20 and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CC)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3/05/2007 have been fully considered but they are not persuasive.

A. Applicant argues (page 9, lines 7-9), "De Boor does not disclose or teach that the computer device suspend any non-phone functions in response to a user selecting the call initiation button.

In response, De Boor is not relied upon for suspending a non-phone function; rather it is used for its teaching of a computing device having phone functions integrated within the device's hardware. Moreover, Hawkins teaches an interrupt signal to the organizer when a telephone call is received (col. 4, lines 30-36) and a selectable answer button to answer a call (col. 8, lines 9-13).

B. Applicant argues (page 9, lines 16-17), "...neither Nokia nor Silberfenig, teach or suggest that the user may take notes based on each associated address entry contained within the address application of the computing device. However, Hawkins teaches that users are permitted to add an entry associated with a telephone number (col. 7, lines 1-2).

Specification

2. The disclosure is objected to because of the following informalities: the specification has a note button 506 but figure 6 has a Details button 506 and a Note

button 508. Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. Claims 17-20 and 22-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 17 recites a "computer- readable medium" that may take the form of a "transmission media" which can take the form of acoustic or light waves (page 28).

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101. First, a claimed signal is clearly not a "process" under § 101 because it is not a series of steps. The other three § 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." 1 D. Chisum, Patents § 1.02 (1994). The three product classes have traditionally required physical structure or material.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-4, 6-20 and 22-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over **De Boor et al** (US 6,173,316 B1; DeBoor hereinafter), **Nokia** (Nokia 6160 Owner's Manual, published September 1998), **Silberfenig et al** (US 2001/0041590) and **Hawkins et al** (US 6,516,202 B1).

Claims 1, 10 and 17:

DeBoor discloses a wireless communication device (palmtop computer, personal information manager, cellular telephone) having a user interface that allows a user to access both the Internet and telecommunication functions (abstract; col. 1, lines 13-31; col. 5, lines 15-29; col. 6, lines 60-67; col. 9, lines 16-30). The interface enables the user to initiate a phone call (col. 8, lines 25-62; col. 9, lines 7-15; col. 10, lines 12-33; col. 11, lines 14-19; col. 12, lines 8-11; col. 13, lines 10-33; col. 35, lines 32-36, 48-58). The computing device has phone functions integrated within the computing device's hardware (fig. 1; col. 8, lines 23-33).

DeBoor does not teach that a phone call is placed to a last called phone number if digits are not received from the interface just before a dial signal is received in response to the user selecting a call initiation button. However, **Nokia** discloses a cellular telephone that automatically stores the numbers the user has dialed (p. 33-34, see: Dialed calls) and enables users to initiate a phone call by pressing an initiation

button (Talk button). The phone call is placed to a last dialed (called) number (p. 41, see: Last number redial). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify DeBoor's mobile computer to include a redial or call-previously-entered-phone-number features because it saves the user precious time (especially when the phone number that is being called is busy for a long time or when several continuous calls to the same number are necessary) by enabling the caller to just press the Talk button over and over again until the call gets through.

DeBoor/Nokia does not teach deactivating a microphone by selecting a mute button during a phone call and replacing the mute button (activating a speak button) with a speak button by selecting the mute button during the phone call. However, **Silberfenig** discloses a cellular telephone having a mute button for deactivating a microphone and replacing the mute button with a speaker when releasing the mute button to reestablish the microphone (page 3, pgs. 0028-0029, 0032; page 4, pgs. 0036, 0038). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention to modify DeBoor/Nokia phone interface to include a mute button because the local user is allowed to participate in a private conversation or local conference during the telephone call without being heard by the remote user.

DeBoor/Nokia/Silberfenig does not teach suspending non-phone functions in response to user selection of a call initiation button and a note button for inputting notes associated with an address entry. However, **Hawkins** discloses a mobile computer

having an organizer and a cellular telephone. Hawkins explains that the computer has a micro-controller that sends an interrupt signal to the organizer when a telephone call is received (col. 4, lines 28-36). Hawkins also teaches an address book wherein the user is enabled to search telephone numbers and add entries about a current address entry (col. 7, lines 1-2). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify DeBoor/Nokia/Silberfenig's communication device to include Hawkins' teachings of suspending other functions or applications when receiving a telephone call because the user won't have to worry about missing an important call while using other functions of the computer; and also include Hawkins' teachings of allowing users to input notes associated with an address entry because the user is enabled to store telephone numbers of received calls and enter the name of the person associated with that telephone number and also to edit that information when it changes.

Claims 2, 3, 18 and 19:

See claim 1. Nokia's Talk button is a hard button (see cited paper illustrating the Nokia 6160).

Claims 4, 13, and 20:

DeBoor teaches that the user does not need to switch between different applications; the device uses markup language, which allows a current application to be paused or suspended when the application is other than the call device (col. 2, lines 23-47; col. 4, lines 61-67; col. 5, lines 1-29; col. 8, lines 38-42; col. 41, lines 51-56; col. 55,

lines 17-42).

Claims 6 and 22:

DeBoor teaches searching the memory of the organizer for a name associated with a phone number (col. 5, lines 20-29).

Claims 7 and 23:

DeBoor teaches timer functions (col. 8, lines 37-38) and Nokia teaches call timers configured to clock the duration of a connection with other phone device (page 29).

Claims 8 and 24:

DeBoor teaches receiving a save signal to save a phone number and initiating an address entry application in response to receiving the save signal (col. 35, lines 48-58).

Claims 9 and 25:

DeBoor teaches a screen that provides the options of hanging up (ending connection), (col. 38, lines 41-43, 63-65).

Claim 11:

DeBoor teaches that phone calls are placed and received (send, answer, ignore calls) according to the user selections (col. 9, lines 7-14; col. 19, line 3; col. 21, lines 11-23).

Claims 12, 14, and 15:

Silberfenig teaches the communication device has a display screen and email

functions that enable a user to enter data by using a keyboard or a touch-sensitive screen, the screen having software-generated keys that can be selected using a stylus; the device being capable of identifying tap input from a user (p. 5, par. 0043).

Claim 16:

See claim 12. Silberfenig teaches a microphone connected to the communication device, which is configured to receive audio input from a user. The microphone may be deactivated when the user uses the mute button (p. 4, par. 0036, 0038, 0040).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to X. L. Bautista whose telephone number is (571) 272-4132. The examiner can normally be reached on Monday-Thursday 8:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/X. L. Bautista/

Primary Examiner, Art Unit 2179

July 08, 2008